



PATENT
7284/52829-R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : David G. Bird
Serial No. : 08/862,039
Filed : May 22, 1997
For : LOCATION OF MISSING VEHICLES
Group A.U. : 3662
Examiner : T. Blum

For Reissue of Original Patent
No. 5,418,537 issued May 23, 1995
Appeal No.:

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Donald S. Dowden
Reg. No. 20, 701

Date
October 15, 2001

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REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This brief, filed in triplicate, is in reply to the Examiner's Answer mailed August 15, 2001. Appellant continues to rely on the Brief on Appeal filed January 24, 2001, and in addition makes the following observations on selected sections of the Examiner's Answer.

*noted -
T. Blum
(3662)*

§§3 and 6. Status of Claims; Issue Presented

The final Office Action, dated May 16, 2000, states in section 1 on page 2: "Claims 1-59 [sic; not 28-59] are rejected since these claims recapture claimed subject matter deliberately canceled in application serial No. 07/978,272."

Appellant's Brief on Appeal quotes the Examiner's language and adds (page 3): "It is understood that the rejection of claims 1-27 would be withdrawn if claims 28-59 were either allowed or canceled."

The Examiner has confirmed appellant's understanding by stating, in §§ 3 and 6: "since claims 1-27 have not been amended, recapture does not apply to these claims." The Examiner makes a similar statement in §11 on page 15.

§7. Grouping of Claims

In §7 on page 3 of the Examiner's Answer, the Examiner states that "The rejection[s] of claims 1-59 [sic; it is understood that the Examiner intended to refer to claims 28-59 (see above)] stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof."

Appellant respectfully traverses the Examiner's argument.

Group A

The claims of group A (original patent claims 1-27, which have been retained without amendment) are now clearly off the table, since the Examiner agrees in §6 that the rejection does not apply to them. That leaves the claims of groups B and C.

Groups B and C

The Examiner cites 37 C.F.R. §1.192(c)(7) as requiring that groups B and C be collapsed into a single group. Appellant respectfully disagrees. Appellant's Brief on Appeal states at the bottom of page 4 that the claims of group B are alike, that the claims of group C are alike, and, by implication how the claims of group B differ from those of group C. Moreover, at pages 4 et seq. of the Brief on Appeal, appellant separately compares the features characteristic of the claims of groups B and C to claims presented in the original application. It is possible in principle for the Board to agree with the appellant that the features of the claims of group B are not found in any claims canceled from the original application, but conclude that the features of group C are found in canceled claims; or to agree with the appellant that the features of the claims of group C are not found in any claims canceled from the original application, but conclude that the features of group B are found there. Consequently, the claims of groups B and C should be considered separately.¹

¹ Although arguing in §7 that the claims of groups B and C should be collapsed into a single group, the Examiner in fact treats them separately in §11.

§10. Reply to Grounds of Rejection (Examiner's Answer, pages 4-15)

The appellant respectfully submits that the Examiner's statement of the recapture doctrine and of the relationship between the reissue claims of groups B and C to the claims canceled from the original application is incorrect.

(a) The Recapture Doctrine

The recapture doctrine prevents a patentee from recapturing, through reissue, subject matter deliberately surrendered in an effort to obtain allowance of the original patent claims. Ball Corp. V. United States, 729 F.2d 1429, 221 U.S.P.Q. 289 (Fed. Cir. 1984). See also B.E. Meyers & Co., V. United States, 56 U.S.P.Q.2d 1110 (Ct. Cl. 2000), Exhibit C to Brief on Appeal. The recapture doctrine does not apply to the facts of the present case because the appellant is not attempting to "recapture" any subject matter he previously gave up. The subject matter of a claim is measured by the totality of the claim (the combination of the features it recites), not by any of its features considered in isolation. While reissue claims 28-59 are broader than those canceled from the original patent application in some respects, they are materially narrower in other respects: that is, they contain narrowing limitations that, in combination with the other recitations in the respective claims, led to their being declared patentable over the prior art.

The Examiner states the recapture doctrine in various ways but nowhere recognizes the need to consider, in accordance with Ball Corp. and Meyers, supra, whether the reissue claims

are materially narrower in certain respects than the canceled claims. The following excerpts from the Examiner's Answer are representative of the Examiner's understanding of the recapture doctrine:

"A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application." (pages 4-5)

"Claim 28 recited in serial No. 07/978272 was allowed in view of [a certain limitation]. Any reissue claim must have this limitation, since it was this limitation that the record (page 21 in amendment A) showed was the reason claim 28 was allowed and by arguing this limitation, applicant surrendered any claim lacking this limitation." (pages 6-7)

"Any reissue claim must have the limitation of dependent claim 11, since it was this limitation that the record (amendment A in serial No. 07/978272) shows was the reason claim 32 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 11." (page 7)

The third passage quoted above, which relates to original application claims 11 and 32, is essentially repeated at page 8 with respect to original application claims 1, 12 and 33; at page 9 with respect to original application claims 13, 25 and 35; at page 10 with respect to original application claims 13, 26 and 36; at page 11 with respect to original application claims 10, 31 and 39; and at page 12 with respect to original application claims 23, 24, and 41. Were the Board to accept the Examiner's view of the recapture doctrine, the broadest reissue claim allowable would be remarkably narrow, since it would recite, in combination, features selected from original application claims 1, 10-13, 23-25, 28, 31-33, 35, 36, 39 and 41. That view of the recapture doctrine subverts 35 U.S.C. §251, which expressly sanctions broadening reissues. The

Examiner's view of the recapture doctrine does not take the controlling statute into account.

Moreover, a broadening aspect that may relate to subject matter deleted from claims in the original application (by canceling claims from the original application or adding limitations to retained claims) does not prohibit reissue if the reissue claims are narrower than the canceled claims because of other material limitations. Ball Corp., 729 F.2d at 1436; Application of Willingham, 282 F.2d 353, 356 (C.C.P.A. 1960) and Meyers, 56 U.S.P.Q.2d at 1116.

The analysis in the Examiner's Answer purporting to show that any reissue claim is barred by the recapture doctrine if it lacks a limitation that the record shows was "the reason" a particular claim was allowed is incorrect for at least two reasons: (1) the claims of groups B and C here have been separately allowed over the prior art. Accordingly there is no reason for any of them to contain a limitation that may have been a reason for allowance of a previously canceled claims; (2) the Examiner's analysis confuses the elements of a claim with the meaning of the claim considered as a whole. For example, if a claim ABC requires each of limitations A, B and C in order to be patentable, then the deletion of any one, with no other amendment, renders the claim unpatentable. But that does not mean that claim ABX, ACX or BCX is either unpatentable or, if presented in a reissue application, barred by the recapture doctrine.

(b) The Examiner's Characterization and Comparison of Reissue and Canceled Claims

The Examiner states on page 14 that reissue claim 28 is "broader" in all aspects than

original application claim 31. That of course is incorrect. As the Examiner recognizes in §11, reissue claim 28 calls for employing a communications device separate from, and for operation independent of, a paging request responder. Original application claim 31 contains no such limitation.² The Examiner states at page 15 of the Examiner's Answer that a reissue claim cannot be broader than a canceled claim (of the original application) in all aspects. But that relationship ("broader in all aspects") is not the relationship between the reissue claims and the canceled claims in the present instance. The Examiner further states at page 15 that all reissue claims must retain at least one of the reasons (limitations) which "made" the original patent claims allowable. As indicated above, this cannot be true where the reissue claim contains other different limitations that make it allowable.

² Original application claim 31 reads as follows:

31. A method of determining the present location of a missing vehicle, the method comprising the steps of:

- providing a vehicle with a vehicle location signal antenna and receiver/processor, connected to the antenna, where the antenna receives position location signals and the receiver/processor uses these signals to determine the present location of the vehicle on which the antenna and the receiver/processor are located;

- providing the vehicle with a page responder to respond to a page request broadcast by a vehicle location service or paging service;

- providing the vehicle with a cellular telephone that may be activated to place a telephone call to a selected telephone number;

- providing the vehicle with a controller/modem that is electrically connected to, and controls the operation of, the receiver/processor, the page responder and the cellular telephone;

- when the vehicle is determined to be missing, causing the vehicle location service or paging service to broadcast a page requesting the present location of the missing vehicle;

- causing the page responder in the vehicle to receive the page request and, in response thereto, to cause the controller/modem to interrogate the receiver/processor concerning the present location of the vehicle;

- causing the receiver/processor to obtain information on the present location of the vehicle and to provide this information for the controller/modem; and

- causing the controller/modem to cause the cellular telephone to contact a selected vehicle location service or paging service and to communicate information on the vehicle present location to the vehicle location service or paging service,

- whereby information on the present location of the vehicle is made available to an owner or operator of the missing vehicle.

§11. Appellant's Reply to Examiner's "Response to Argument"

The Examiner states on page 16:

"[Original patent claims] 1-27 do not recite a communications device capable of operation independent of a paging request responder. As a result, the Group B claims (claim 54 for example) are broader than patented claims 1-27."

It is not apparent why the Examiner compares retained claims 1-27 to any reissue claims, since that comparison has no bearing on the issue of recapture. In any case, the first sentence of the quoted passage is true: claims 1-27 do not recite a communications device capable of operation independent of a paging request responder. However, the second sentence of the quoted passage gets it backwards. The entailment of the first quoted sentence is not that the group B claims are broader than the patented (and now reissue) claims 1-27 (though of course they are in certain respects) but that they are narrower in the respect that they require such a communications device.

The Examiner states on page 18:

"Claim 38 found in application 07/978,272 recites a communication device capable of operating independently of a paging request responder since the communication means recited in claim 38 is responsive to an event sensor output signal, not a paging signal."

The appellant respectfully disagrees. The quoted passage ignores the fact that in not reciting a communication device capable of operation independently of a paging request

responder, claim 38 is clearly broader than the group B claims. For example, the fact that a communications device is “responsive to” a first signal such as an event sensor output signal in no way means that it is capable of operating independently of some other signal, such as a signal from a paging request responder. In fact, in any practical modern electronic device, there are many signals, and it is in general various confluences of signals that jointly give rise to various downstream signals. No single signal in isolation can be said to be the sole cause of a (different) downstream signal. Devices that fall within the scope of canceled claim 38 are not within the scope of the group B claims. Therefore, the limitation of the reissue group B claims (including reissue claim 54) to a communications device capable of operation independently of a paging request responder is not a limitation of original application claim 38, which instead is clearly broader in having failed to recite that feature.

The Examiner states on page 21 of the Examiner’s Answer that canceled original application claim 37 recited a “noncellular paging request responder”. However, no such limitation appears in canceled application claim 37.³ As with canceled claim 38, canceled claim 37 is clearly broader than the group C claims.

³ Canceled application claim 37 reads as follows:
37. A method for determining the present location of a missing vehicle, the method comprising the steps of:
 providing a vehicle with a page responder to receive a paging request concerning the present location of the vehicle and, in response thereto, to issue a page responder output signal; and
 providing the vehicle with location determination and communication means, connected to the page responder, for receiving the page responder output signal and, in response thereto, for determining the present location of the vehicle and transmitting this present location information to a selected signal receiver for display of this present location.

Conclusion

The Examiner has already held that the rejected claims 28-49 are patentable over the prior art and has never rejected claims 50-59 as unpatentable in view of prior art. The recapture doctrine as the Examiner erroneously understands it would bar all broadening reissues, which is contrary to the statute. Features in the original claims but not the reissue claims are not necessary to patentability, and their omission from the reissue claims is sanctioned by 35 U.S.C. §251. The reissue claims are directed to an invention distinguishable from the claims of the original patent and avoid the recapture doctrine in the same way as the claims in the Ball Corp., Meyers and Willingham reissue cases avoided it. Accordingly, it is respectfully requested that the decision of Examiner finally rejecting the claims be reversed.

Respectfully submitted,
COOPER & DUNHAM LLP



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REQUEST FOR ORAL HEARING ON APPEAL

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant/Appellant hereby requests an Oral Hearing in Applicant's appeal in the application identified above.

The fee of \$280.00 accompanies this request. However, the Commissioner is hereby authorized to charge any additional fees may be required or credit any overpayment to Deposit

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This paper is being filed in triplicate along with Appellant's Reply Brief.

Respectfully submitted,
COOPER & DUNHAM LLP

A handwritten signature in cursive script, appearing to read "William E. Pelton".

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